REMARKS

Applicant has amended the claims in order to more particularly define the invention taking into consideration the outstanding Official Action. Claims 1-11 have been canceled from the application without prejudice or disclaimer and replaced with corresponding claims 12-21 which are fully supported by Applicant's specification. Applicant most respectfully submits that all the claims now present in the application are in full compliance with 35 U.S.C. 112 and are clearly patentable as they fully comply with all sections of the statute.

The specification is objected to under 35 U.S.C. 112 and 37 CFR 1.171 because it is alleged that it fails to provide an adequate written description of the invention and fails to provide an enabling disclosure.

In this regard, it is specifically noted in the Official Action that the specification fails to set forth the type of molecular weight for component B, polyalkylene glycol. Specific reference is made to pages 3-10 of the specification. It is further urged that there is no guidance or direction of the type of molecular used to make the modified polyester filament of claim 1 in component B polyalkylene glycol. It is also urged that there are no working examples of the type of molecular weight used for the polyethylene glycol of claim 3. It is stated that there would be an undue experimentation burden on the public to practice the invention as claimed. This aspect of the rejection has been carefully considered but is most respectfully traversed since the statute is written in terms of one of ordinary skill in the art to which the invention pertains. The level of one of ordinary skill in the art must be taken into consideration in evaluating compliance with the statutes. Accordingly, when one considers the level of skill of one of ordinary skill in the art to which the invention pertains, one would find that such a person is fully enabled by the specification, without undue experimentation. In this regard the Examiner's attention is most respectfully directed to the MPEP.

In particular, § 2164.01 Test of Enablement is noted. As stated therein, any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of Mineral Separation v. Hyde, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Accordingly, even though the statute does not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Determining enablement is a question of law based on underlying factual findings. In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); Atlas Powder Co. v. E.I. du Pont de Nemours & Co., 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

UNDUE EXPERIMENTATION The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. In re Certain Limited-Charge Cell Culture Microcarriers, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also In re Wands, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976). 2164.01(a) Undue Experimentation Factors There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue."

These factors include, but are not limited to: (A) The breadth of the claims; (B) The nature of the invention; (C) The state of the prior art; (D) The level of one of ordinary skill; (E) The level of predictability in the art; (F) The amount of direction provided by the inventor; (G) The existence of working examples; and (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988) (reversing the PTO's determination that claims directed to methods for detection of hepatitis B surface antigens did not satisfy the enablement requirement).

The objection to the specification is related to the rejection of claims 1-11 under 35 U.S.C. 112, first paragraph, for the reasons discussed above. That is, a lack of adequate teaching with respect to the molecular weight.

In this regard, one of ordinary skill in the art would appreciate that the present invention relates to a modified polyester filament, hetero-shrinkage conjugated polyester filament made by combining the modified polyester filament with high boiling water

shrinkage filament and drawn twisting, especially to a polyester filament 0.1 to about 0.001 d.p.f. ultrafine fluffs.

As stated on page 1 of Applicant's specification, polyester can be widely used in versatile usages such as filament, film packaging container and engineering plastics wherein filament is the most used. It is noted that there are certain problems associated with it such as no water absorption, rough, no smooth hand etc. Especially in the clothing use, hand of fiber is the key pint of commercial value. To improve the deficiencies of rough, no smooth hand, many recommendations have been provided. These are fully set forth on pages 1 and 2 of Applicant's specification.

In the Summary of the Invention, it is pointed out that the object of the invention is to provide a modified polyester filament of ultrafine fluffs thereon, the filament obtained has soft, puffy, dry feeling and natural fiber like hand. Clearly, one of ordinary skill in the art based upon the information provided would know the type of molecular weight associated with the polyethylene glycol used for the present invention. Component B is a polyalkylene glycol which is specified as a type of molecular weight of 20,000 with reference to line 4 of Example 1 and Examples 1-4. Table 1 also contains an expression of the type of molecular weight of the polyethylene glycol used. Reference is made to Example 5, 6 of Table 1 for the expression 10,000 - 30,000 which are all known by the person skilled in the art. The product such as PEG 20,000 can be found in the catalogs found on the Google website which are commercially available for many suppliers such as Merck KgaA Co., and so on. This would be fully appreciated by one of ordinary skill in the art to which the invention pertains.

Thus, one of ordinary skill in the art would clearly appreciate that component B, the polyalkylene glycol used in the working examples defined as PEG 20,000 is a molecular weight of 20,000 can be easily derived from the description. The manner in which the molecular weight is determined would also be appreciated by one of ordinary in the art and Applicant most respectfully submits that the filing of a continuation-in-part

application is not necessary taking into consideration the level of one of ordinary skill in the art to which the invention pertains. Accordingly, it is most respectfully requested that this rejection be withdrawn.

In view of the above comments and further amendments to the claims, favorable reconsideration and allowance of all of the claims now present in the application are most respectfully requested.

Respectfully submitted,

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REF:kdd
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September 7, 2004